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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	08/661,834	
	Filing Date	06/11/1996	
	First Named Inventor	Kronzer	
	Group Art Unit	BPAI 3761	
	Examiner Name	Board of Patent Appeals	
Total Number of Pages in This Submission	12	Attorney Docket Number	45751USA6C.012

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Declaration of Joseph Kronzer
Remarks Includes a Request for Rehearing		

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Frank Rosenberg
Signature	<i>Frank Rosenberg</i>
Date	05/14/2002

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: May 14, 2002			
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Signature	<i>Esmeralda Mestizo</i>	Date	May 14, 2002

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PATENT
Docket No.: 45751USA6C.012

#41
B. Webb
6/28/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOSEPH P. KRONZER ET AL.

Serial No.: 08/661,834

Filed: June 11, 1996

For: FIBROUS FILTRATION FACE MASK

**Board Of Patent Appeals And
Interferences**

Administrative Patent Judges Irwin
Charles Cohen, Neil E. Abrams, and
Jeffrey V. Nase

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REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. §1.197(b)

Assistant Commissioner for Patents
Board Of Patent Appeals And Interferences
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Honorable Sirs:

In the Opinion mailed March 19, 2002, the Board Of Patent Appeals And Interferences (hereinafter "the Board") reversed the Section 112 rejection and sustained the Section 103 in view of Dyrud et al. (U.S. Patent No. 4,807,619).

Appellants submit that the Board's Decision has misapprehended or overlooked the following facts and points of law: (1) contrary to the conclusion in the Decision, none of the surface fuzz values in appellants' comparative examples exceeded 8.0; (2) the Dyrud patent does not inherently possess the claimed surface fuzz values; (3) there is no motivation in the prior art to select 100% bicomponent fibers amongst Dyrud's generic disclosure of a broad range of fiber compositions; and (4) the opinion misapprehended or overlooked the record and the facts regarding obviousness. These four issues are separate and independent grounds, any one of which is sufficient to overcome the rejection in view of Dyrud.

I. THE BOARD'S CONCLUSION IN THE SENTENCE BRIDGING PAGE 8 AND 9 MISAPPREHENDED THE FACTS

On Page 8-9 of the Opinion, the Board states:

Thus, the value "8.0" in the cited column of Table 1 is not the maximum achieved by each of the six shells, but is an average of the surface fuzz values of the six shells, that is, the middle point between extremes. **In the absence of evidence to the contrary**, this gives rise to the conclusion that while the fuzz value of some of the six shells tested was less than 8.0, the fuzz value of at least one of the others was greater than 8.0.

Page 8-9 of the Opinion, emphasis added.

The attached Declaration of Joseph Kronzer is definitive evidence to the contrary. The Board is incorrect, the fuzz value of at least one of the others was not greater than 8.0. As shown in the attached Declaration, all six fuzz values were exactly 8. None of the six values exceeded 8.0. Therefore, the Board's reasoning in sustaining the rejection is not supported by the facts. Accordingly, the rejection in view of Dyrud should be reversed.

The attached Declaration was not submitted earlier because the Board's reasoning differs from the Examiner's reasoning. See the Examiner's Answer.

II. THE OPINION OVERLOOKED THE LAW REGARDING INHERENCY

A. The Claimed Fuzz Value Is Not Inherent In Dyrud's Masks

Although unstated, the Board's reasoning appears to be based on an assertion that the claimed surface fuzz value is an inherent property of Dyrud's masks. This basis for sustaining the rejection overlooked the standard for inherency.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-1951 (Fed. Cir. 1999); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) ("In relying upon the theory of inherency, the

examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.”)(emphasis in original). Dyrud’s methods for making masks are significantly different from appellants’ methods, and there is no basis to believe that the claimed surface fuzz value would be necessarily present in Dyrud’s webs.

B. Even If The Claimed Fuzz Values Would Occur In Masks Hot Pressed From 100% Bicomponent Fibers, The Claimed Invention Would Still Be Patentable Over Dyrud

Even if use of 100% bicomponent fibers in Dyrud’s methods could have exceeded a surface fuzz value of 8.0, that would not provide a legally sufficient basis for sustaining the prior art rejection. The possibility that conditions could be selected from a generic disclosure to obtain the claimed properties is not sufficient to sustain a prior art rejection. As the Federal Circuit discussed in *Ultradent*, “Even if the . . . tests confirm [defendant’s] contention that the compositions containing 3% and 5% carboxymethylene provide the level of viscosity and stickiness required by the claims of the [plaintiff’s] patent, that does not mean that the claimed matrix material is necessarily described by the [cited] patent. . . . [T]here are many possible compositions that could be made within the range of carboxymethylene concentration 0.05% to 5% that the [cited] patent discloses. [Defendant’s] burden at trial was to show that the [cited] patent would describe to one of skill in the art . . . combinations meeting the limitations of the claims, from among the many possible candidates.” *Ultradent Prod., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 44 U.S.P.Q.2d 1336 (Fed. Cir. 1997). See also *Suntiger, Inc. v. Scientific Research Funding Group*, 189 F. 3d 1327, 81 U.S.P.Q.2d 1811 (Fed. Cir. 1999) citing *In re Ruschig*, 379 F.2d 990, 154 U.S.P.Q. 122 (C.C.P.A 1967) (“The case law makes clear that disclosure of a generic expression encompassing a large number of possible variants is not a description of all of them.”) Dyrud broadly disclosed use of 25 to 100% bicomponent fibers. None of Dyrud’s examples use 100% bicomponent fibers, and there is no suggestion of any special desirability of masks made from 100% bicomponent fibers. Thus, even if a mask hot pressed from 100% bicomponent fibers inherently possessed the claimed surface fuzz value (which it does not), the Dyrud patent would not render the claimed masks unpatentable because there is no motivation in the prior art to select 100% bicomponent fibers amongst Dyrud’s generic disclosure of a broad range of fiber compositions.

III. THE OPINION MISAPPREHENDED OR OVERLOOKED THE RECORD AND THE FACTS REGARDING OBVIOUSNESS

First, there is no proper basis for establishing a *prima facie* case of obviousness over the claimed invention including the claimed surface fuzz value. Indeed, the Patent Examiner had conceded that Dyrud did not teach or suggest the claimed fuzz value: “Appellants conjecture regarding the maximum fuzz value attainable using the method of molding as disclosed by Dyrud may be accurate; however, since the claims do not define a method of cold molding these conclusions are of no relevance in distinguishing over the prior art to Dyrud.” See Examiner’s Answer, page 9, lines 3-6 (emphasis added).

Dyrud does not suggest modify process conditions such that a surface fuzz value exceeding 8.0 would be obtained. Nor is a surface fuzz value exceeding 8.0 inherent in Dyrud’s masks. Thus, a *prima facie* case of obviousness has not been established.

Second, even if a *prima facie* case of obviousness had been established, the unexpected and superior results establish patentability over the alleged *prima facie* case of obviousness. The Board has overlooked its own statement that:

The specification goes on to state that “[a] comparison of the results of these examples with examples 1-23 demonstrate that the method of the present invention provides unexpected superior results over hot molding processes for forming shaping layers of thermally bonding fibers.” If a fuzz value of greater than 8.0 is considered to be the criterion for “superior,” 14 of the 26 averages meet this standard.

Be that as it may, the issue before us is whether shells made in accordance with the Dyrud method fall within the scope of claim 25.

Decision On Appeal, page 8 (emphasis added). From the above-quoted statement, it appears that the Board does not dispute that applicants have shown “unexpected superior results.” Even if Dyrud established a *prima facie* case of obviousness over the claimed invention (which, for the reasons discussed in sections I and/or II of this Request, it clearly does not), the unexpected superior results would overcome that *prima facie* case. The Board’s opinion acknowledged the assertion of unexpected superior results, but then improperly overlooked these same results.

IV. DISCRETIONARY STATEMENT OF ALLOWABILITY BY THE BOARD

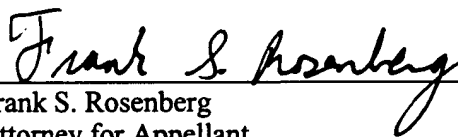
Appellants respectfully submit that in view of the above discussion, all claims are clearly allowable over the cited art. If the rejection is still sustained, however, then Appellants request, pursuant to 37 CFR 1.196(c), that the Board use its discretionary authority to issue an explicit statement that the claims may be allowed in amended form. For example, the Board could explicitly state that the claims could be made allowable by addition of the term "average;" as in "average surface fuzz value." Alternatively, the Board is urged to explicitly state that the claims could be made allowable by addition of a limitation of the dependent claims such as wherein the surface fuzz value is not less than 8.4 (claim 31), or not less than 9.0 (claim 28), or not less than 9.1 (claim 37), or not less than 9.5 (claim 35). Such a statement would be helpful in expediting prosecution of the application.

CONCLUSION

For the reasons discussed above, the Board's Decision has misapprehended or overlooked the following facts and points of law: (1) contrary to the conclusion in the Decision, none of the surface fuzz values in appellants' comparative examples exceeded 8.0; (2) the Dyrud patent does not inherently possess the claimed surface fuzz values; (3) there is no motivation in the prior art to select 100% bicomponent fibers amongst Dyrud's generic disclosure of a broad range of fiber compositions; and (4) the opinion misapprehended or overlooked the record and the facts regarding obviousness. If the Board agrees with even one of these four separate grounds for patentability, the prior art rejection cannot be sustained.

Dated this 14th day of May, 2002.

Respectfully submitted,



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Esmeralda Mestizo

Dated: May 14, 2002